

## **REMARKS**

Applicants respectfully request entry of the following amendments and remarks contained herein in response to the Non-Final Office Action mailed January 27, 2006. Applicants respectfully submit that the amendments and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 53 – 109 remain pending. In particular, Applicants amend claims 53, 64, 75, 86, 92, 98 and 103 – 106, and claims 1 – 52 remain cancelled. Applicants reserve the right to pursue the subject matter of these cancelled claims in a continuing application, if Applicants so choose, and do not intend to dedicate the canceled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **I. Examiner Interview**

Applicants first wish to express their sincere appreciation for the time that Examiner Ouellette spent with Applicants' Attorney, Jeffrey R. Kuester during general telephone discussions on April 5, 2006, and April 7, 2006. During those conversations, Examiner Ouellette explained the 35 U.S.C. §112, first paragraph, concerns with the pending independent claims. The amendments made herein are designed to at least address those concerns, as well as clarify claim limitations. Thus, Applicants respectfully request that Examiner Ouellette carefully consider this response and the amendments.

### **II. Priority**

In the Office Action, Applicants' claim to priority under 35 U.S.C. § 119 (e) to provisional applications 60/173,919 and 60/192,862 is acknowledged, but adequate support under 35 U.S.C. § 112 for claims certain claims in their previous form is allegedly not provided by those provisional applications. At this point, Applicants do not address the validity of that conclusion; consequently, Applicants do not intend to express agreement or disagreement therewith.

### **III. Rejections Under 35 U.S.C. §112**

The Office Action indicates that certain claims stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement and distinctly claim the subject matter which Applicants regard as the invention. While Applicants submit that the claims as previously pending were allowable as written, Applicants have nonetheless amended these claims in the interest of advancing prosecution. With regard to one example embodiment, among others, the written description requirement for the amended features is addressed in the present application on pages 48 – 51, and more specifically, on lines 3 – 7 of page 51. Accordingly, Applicants submit that the claims as currently pending are clearly allowable.

### **IV. Rejections Under 35 U.S.C. §103(a)**

The Office Action indicates that the pending claims are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 6,298,327 ("*Hunter*") in view of U.S. Patent Number 6,061,660 ("*Eggleston*"). Applicants respectfully traverse these rejections on the grounds that *Hunter* in combination with *Eggleston* does not disclose, teach, or suggest all of the claimed elements. More specifically, Applicants submit that neither *Hunter* nor *Eggleston* include determining how an intellectual property asset should be utilized, including generating an intellectual property licensing rights utilization decision for at least one intellectual property asset. Instead, *Hunter* discloses facilitating evaluation of market value of an invention itself, which is very distinct from the claimed feature, and *Eggleston* does not cure this deficiency.

The Office Action also concludes that various claimed distinctions are found only in nonfunctional descriptive data and are not functionally involved in the claims. Applicants first submit that those conclusions are now rendered moot. In addition, however, Applicants do not admit that any of the claimed differences are found only in nonfunctional descriptive data or are not functionally involved in the claims.

**CONCLUSION**

In conclusion, Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and presently pending claims be allowed to issue.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,

**THOMAS, KAYDEN, HORSTEMEYER  
& RISLEY, L.L.P.**



By: \_\_\_\_\_

**Jeffrey R. Kuester, Reg. No. 34,367**

100 Galleria Parkway, NW  
Suite 1750  
Atlanta, Georgia 30339-5948  
Tel: (770) 933-9500  
Fax: (770) 951-0933